Supreme Court, U.S.
FILED
07-406 SEP 19 2007
OFFICE OF THE CLERK

No: (1)

IN THE

Supreme Court of the United States

XIAOMING WANG,

Petitioner

v.

CHINA HEALTHWAYS INSTITUTE, INC.
(doing business as Chi Institute)

Respondent

On Petition For Writ Of Certiorari
To The United States Court Of Appeals
For The Federal Circuit

PETITION FOR WRIT OF CERTIORARI

Xiaoming Wang
P.O.Box 21146
Bakersfield, CA 93390
(714) 878-5569

QUESTIONS PRESENTED

Whether the Court of Appeals erred in allowing a descriptive mark "CHI", which is one of the most famous words in Chinese culture and which is also used to describe the function or the characteristics of a special type of Chinese healing device (Chi Kung Therapeutic Apparatus), to be protected under the Lanham Act?

Whether a foreign word needs to be analysis for its descriptiveness under the "doctrine of foreign equivalents"?

TABLE OF CONTENTS

Page

QUESTIONS PRESENTED ii

TABLE OF CONTENTS iii

TABLE OF AUTHORITIES iv

OPINIONS BELOW.....1

JURISDICTION.....2

CONSTITIONAL AND STATUTORY
PROVISIONS INVOLVED.....3

STATEMENT OF THE CASE.....4

REASONS FOR GRANTING THE WRIT.....10

CONCLUSION.....16

APPENDIX.....17

A. Opinion of United States Court of Appeals
for the Federal Circuit.....17

B. Opinion of United States Patent and Trademark
Office, Trademark Trial and Appeal Board.....30

TABLE OF AUTHORITIES

Page

Abercrombie & Fitch Co. v. Hunting World, Inc.,
537 F.2d 10 (2nd Cir. 1976).....13

Ale House Management, Inc. v. Raleigh Ale House, Inc.,
205 F.3d 137, 141 (4th Cir. 2000).....15

Ashley Furniture Indus., Inc. v. SanGiacomo N.A. Ltd.,
187 F.3d 363, 369 (4th Cir. 1999).....14

Comm. for Idaho's High Desert, Inc. v. Yost,
92 F.3d 814, 822 (9th Cir. 1996).....14

Enrique Bernat F., S.A. v. Guadalajara, Inc.,
210 F.3d 439, 443 (5th Cir. 2000).....10,11

Filipino Yellow Pages, Inc. v. Asian Journal Publications,
198 F.3d 1143, 1151 (9th Cir. 1999).....14

Glover v. Ampak, Inc.
4 F.3d 57, 60 (4th Cir. 1996).....15

John H. Harland Co.,711 F.2d at 974-975.....15

KP Permanent Make-Up, Inc. v. Lasting Impression I, Inc.,

328 F.3d 1061, 1067 (9th Cir. 2003).....14

Miller Brewing Co. v. G. Heileman Brewing Co.,

561 F.2d at 79, ...13

Otokoyama Co. Ltd., v. Wine of Japan Import, Inc.,

175 F.3d 270, 271 (2d Cir. 1999).....11,16

Pebble Beach Co. v. Tour 18 I, Ltd.,

155 F. 3rd 526, 536-537 (5th Cir. 1998).....13

Perini Corp. v. Perini Construction, Inc.,.....15

915 F.2d 121, 124 (4th Cir. 1990)

Sun Banks of Fla. Inc. v. Sun Fed.Sav. & Loan Ass'n.,

651 F.2d 311, 316 (5th Cir. 1981).....15

Other Authorities

In re Tower Tech Inc.,

64 USPQ2d 1314 1316 (TTAB 2002).....14

J. Thomas McCarthy, McCarthy on Trademarks and

Unfair Competition, § 11:34, at 11-66 (2003).....11

The Lanhan Act, 15 U.S.C. 1052. (§2).....11,13

The Lanhan Act, 15 U.S.C. 1052. (§2) e.....11

OPININONS BELOW

The Opinion of the United States Court of Appeals for the Federal Circuit, as *China Healthways Institute, Inc. v. Xiaoming Wang,* appears at Appendix to the Petition for Certiorari (Appendix A) and is unpublished.

JURISDICTION

The date on which the United States Court of Appeals the Federal Circuit decided my case was June 22, 2007.

No petition for rehearing was timely filed in my case because Petitioner was out of county for two months and did not received the judgment of court appeals on time.

The jurisdiction of this Court is invoked under 28 U.S.C. §1254(1).

CONSTITIONAL AND STATUTORY PROVISIONS INVOLVED

The Constitutional and Statutory Provisions at issue:

(1) Trademark Act of 1946 (Lanham Act), Title 15 United States Code Sections 1052 (§ 2): "Namely, the statute: requires that a mark by distinctive, ... authorize registration of a mark on the basis of secondary meaning, and allows the trademark commissioner to presume secondary meaning....."

(2) Lanham Act, Title 15 United States Code Sections 1052 (§ 2) (e): The trademark shall be refused if it "Consists of a mark which (1) when used on or in connection with the goods of the applicant is merely descriptive or..."

(3) Under the "doctrine of foreign equivalents," foreign words are translated into English and then tested for descriptiveness or genericness.

(4) STATEMENT OF THE CASE

The origins of this dispute find their roots in the ancient Chinese concept of healing and well-being. The concept is represented by the Chinese word: 氣, which can be translated to Chi (Qi). It refers to the vital energy or life force that travels in meridians of the body and serves as the basis for Chinese traditional medicine and the science of acupuncture.

In traditional Chinese medicine it is believed that health problems often involve an imbalance of Chi within the body. Over the centuries, the masters of Chi or Chi Kung (Qi Gong) (Chi or Qi means "energy" and Kung or Gong means "exercise and, manipulation") have been trained to release Chi (external Chi) to other people and restore health and well-being.

In the early 1980's the Chinese government asked its scientists to try to debunk the effectiveness of the Chi Kung masters through scientific tests.

One of the tests measured is the energy of sound wave produced by the Chi Kung masters. Those sound waves were measured as emanating in the 8-14Hz ranges (infrasonic sound range or infrasound), and were described as "氣"("Chi" or "Qi") energy.

The scientists developed machines that duplicated those energies of infrasonic sound waves and believed that they mimic the claimed healing powers of Chi Kung masters.

The original name for these units was called the "氣功治疗仪", which can be translated to "Chi Kung Therapeutic Apparatus" or "Qi Gong Therapeutic Apparatus". The machines were populated as a home based healing device and thousands of them were sold in China since 1986.

The term "氣"(Chi or Qi) was used to describe the function or characteristics of these machines as they release "Chi" energy.

The machine is essentially half the size of a shoe box which is plugged into an electric outlet. The box generates a signal transmitted through a cord to a handset. The handset contains a diaphragm that manufactures "Chi", which consisted of energies, including infrasonic sound waves and others. This machine does not like a regular massager, which uses a motor to generate vibration.

Respondent's owner, Richard Lee, found the machine on a visit to China. He signed up with the original factory, Shen Yun Electronic Co. Ltd., as the United States distributor and began to import the machine in 1989. Later, he copied the machine and manufactured it in a different factory in China.

According with the Chinese product marketing information, Respondent also touted the product as reproducing "Chi" or "Qi" energy from Chi Kung or Qi Gong master. Meantime, Respondent claimed that it owns "Chi" as its trademark on the machine.

In addition, the term "CHI" is commonly used for trademark. There are numerous third parties that used similar marks for similar goods and services, like massagers, which were applied in USPTO as follows:

(1) THE CHI MACHINE (Serial No: 76230612);

(2) CHI PULSAR (Serial No: 76303063);

(3) CHI MASTER (Serial No: 75452293);

(4) CHI VITALIZER (Serial No: 78020128);

(5) CHIROSSAGE (Serial No: 73582460);

(6) CHI LITE (Serial No: 75892495);

(7) CHI WELLNESS (Serial No: 76388253);

(8) CHI POUCH (Serial No: 75648496);

(9) HEALING CHI THERAPEUTIC BODYWORKS (Serial No: 78243107).

Xiaoming Wang, Petitioner, as then the exclusive distributor for the original factory, Shen Yun Electronic Co. Ltd., China, applied for registration of the trademark "Chi

PLUS" (stylized letters) in the United States Patent and Trademark Office (USPTO)(Application Serial No. 76/435,273), on July 26, 2002, and declared that the English translation of the word "CHI" in the mark is "ENERGY" and made a disclaimer on the word "CHI". Petitioner's mark describes that the machine releases more Chi energy.

Chi PLUS

(Petitioner's mark)

CHI

(Respondent's mark)

After consideration of various factors, including the Respondent's mark "CHI", the examining attorney of USPTO allowed and published the application in the Official Gazette of May 27, 2003.

Respondent filed an opposition against this registration at the Trademark Trial and Appeal Board

(TTAB) (the Board) of the United States Patent and Trademark Office (USPTO).

The Board denied the summary judgment filed by Respondent on February 16, 2005.

The Board dismissed the appeal filed by Respondent on April 28, 2006 (Appendix B).

Then Respondent filed the current appeal in United States Court of Appeals for the Federal Circuit (Court of Appeals) on August 14, 2006.

This is the continuation of a civil case (No. CV 02-3137-LGB (JWJx) filed by Respondent, in the United States District Court Central District of California, on April 10, 2002

On May 3, 2004, the Federal Court Judge, Hon. Lourdes G. Baird ordered on summary judgment in favor of Petitioner's company East Health Development Group, Inc., and the case was dismissed later.

On June 3, 2004, Respondent filed an appeal on the summary judgment order in United States Court Of Appeals For The Ninth Circuit, and later the appeal was dismissed.

REASONS FOR GRANTING THE WRIT

In today's world of economy, the United States of America is the leader in advancing intellectual property, protecting consumer welfare and promoting competition. The policy of international comity has substantial weight in this situation "because U.S. companies would be hamstrung in international trade if foreign countries granted trademark protection to generic English words, the U.S. reciprocates and refuses trademark protection to generic foreign words." Enrique Bernat F., S.A. v. Guadalajara, Inc., 210 F.3d 439, 443 (5th Cir. 2000).

Under the Lanham Act, §1052. (§ 2)(e), it defines that a mark which when is used on or in connection with the goods of applicant is merely descriptive, should be refused.

Under the Lanham Act, §1052. (§ 2), it allows the trademark commissioner to presume secondary meaning. The United States Patent and Trademark Office should be the government agency to determine the secondary meaning of a descriptive mark.

Under the "doctrine of foreign equivalents," foreign words are translated into English and then tested for descriptiveness or genericness. McCarthy on Trademarks and Unfair Competition, § 11:34, at 11-66 (2003); Enrique Bernat F., S.A. v. Guadalajara, Inc 210 F.3d 439, 443 (5th Cir. 2000); Otokoyama Co. Ltd., v. Wine of Japan Import, Inc., 175 F.3d 270, 271 (2d Cir. 1999).

The United States Patent and Trademark Office should be the government agency to determine the foreign equivalent of a descriptive mark.

However, in this case, the Court of Appeals erred in allowing foreign equivalent of a "descriptive" mark "Chi" to be protected.

The opinion by the Court of Appeals conflicts with the opinion of the Board, as follows:

"Accepting that word "chi" has a meaning in Chinese traditional medicine, the word "chi" does not mean an electric therapeutic massager", (Appendix A, at 27),

"Specifically, the "chi" portion of both marks is at the very least highly suggestive, if not merely descriptive, when used in connection with the involved goods" (Appendix B, at 47, 48).

The Court of Appeals ignored the fact that the mark is used to describe the function or the characteristics of a special type of Chinese healing device, which is broadly classified as the electronic massagers here. It should conduct a validity of the mark analysis before proceeding to the likelihood of confusion inquiry. Pebble Beach Co. v. Tour 18 I. Ltd., 155 F.3d 526, 536-37 (5th Cir. 1998)

The decision of the Court of Appeals (Appendix A) conflicts with the decision the Board (Appendix B) that the Board finds the mark "Chi" not obtaining a second meaning and there is no likelihood of confusion.

Under the Lanham Act, §1052. (§ 2), the United States Patent and Trademark Office should be the government agency to determine if there is likelihood of confusion. "Congress has chosen to leave the exact degree of proof necessary to qualify a mark for registration to the judgment of the Patent Office and the courts" Yamaha Int'l Corp. v. Hoshino Gakki Co., 6 USPQ2nd 1001, 1008 (Fed. Cir. 1988).

A descriptive term is not ordinarily protectable but can, by acquiring a secondary meaning, become a valid trademark. Miller Brewing Co. v. G. Heileman Brewing Co., supra, 561 F.2d at 79; Abercrombie & Fitch Co. v. Hunting World, Inc., 537 F.2d at 10; KP Permanent Make-Up, Inc. v. Lasting Impression I, Inc., 328 F.3d 1061, 1067 (9th Cir.

2003); Ashley Furniture Indus., Inc. v. SanGiacomo N.A. Ltd., 187 F.3d 369 (4th Cir. 1999); Comm. for Idaho's High Desert, Inc. v. Yost, 92 F.3d 814, 822 (9th Cir. 1996).

A term does not have to describe every quality, feature, function, etc. of the goods or services in order to be merely descriptive. It is sufficient for the purpose if it describes a single significant quality, feature, function, etc. In re Tower Tech Inc., 64 USPQ2d 1314, 1316 (TTAB 2002). The question is simply whether someone who knows the goods will understand the term to convey information about them. In re Tower Tech Inc., 64 USPQ2d 1314, 1316 (TTAB 2002).

Moreover, when descriptive marks are especially weak, the Ninth Circuit requires a strong showing of strong secondary meaning. Filipino Yellow Pages, Inc. v. Asian Journal Publications, 198 F.3d 1143, 1151 (9th Cir. 1999), Common words or even uncommon words used in a generic sense will not be afforded trademark protection and the

public has the right to use the common descriptive name for a product. Perini Corp. v. Perini Construction, Inc., 915 F.2d 121, 124 (4th Cir. 1990); Ale House Management, Inc. v. Raleigh Ale House, Inc., 205 F.3d 137, 141 (4th Cir. 2000); Glover v. Ampak, Inc. 74 F.3d 57, 60 (4th Cir. 1996).

Also important in gauging the strength of a mark is the degree to which third parties make use of the mark. *See John H. Harland Co.*, 711 F.2d at 974-75; *Sun Banks of Fla., Inc. v. Sun Fed. Sav. & Loan Ass'n*, 651 F.2d 311, 316 (5th Cir. July 20, 1981). In this case, there are numerous third parties used similar marks for similar goods, like massagers.

In this case, Respondent has chosen the word "CHI" that is descriptive and thus preempts or limits competitors' use of the term to describe their products. "No merchant may obtain the exclusive right over a trademark designation if that exclusivity would prevent competitors from designating a product as what it is in the foreign language their customers

know best" Otokoyama Co. Ltd., v. Wine of Japan Import, Inc., 175 F.3d 270, 271 (2d Cir. 1999).

CONCLUSION

Petitioner respectfully requests that the petition for a writ of certiorari should be granted.

Respectfully submitted,

Dated: September 18, 2007

By _____

Xiaoming Wang, M.D., Ph.D.

P.O. Box 21146
Bakersfield, CA 93390
(714) 878-5569

As Petitioner, Pro Se

APPENDIX A

Opinion by NEWMAN, Circuit Judge, FRIEDMAN, Senior Circuit Judge, RADER, Circuit Judge, of the UNITED STATES COURT OF APPEALS FOR THE FEDERAL CIRCUIT, filed June 22, 2007.

United States Court of Appeals for the Federal Circuit

2006-1464

(Opposition No. 91/157,392)

CHINA HEALTHWAYS INSTITUTE, INC.
(doing business as Chi Institute),
Appellant,

v.

XIAOMING WANG,
Appellee.

David Z. Ribakoff,
Law Offices of David Z. Ribakoff, of Los Angeles,
California, for appellant.

Xiaoming Wang, of Bakersfield, California, pro se.

Appealed from: United States Patent and Trademark Office,

Trademark Trial and Appeal Board

United States Court of Appeals for the Federal Circuit

2006-1464

(Opposition No. 91/157,392)

CHINA HEALTHWAYS INSTITUTE, INC.

(doing business as Chi Institute),

Appellant,

v.

XIAOMING WANG,

Appellee.

DECIDED: June 22, 2007

Before NEWMAN, Circuit Judge, FRIEDMAN, Senior Circuit Judge, and RADER, Circuit Judge.

NEWMAN, Circuit Judge.

China Healthways Institute, Inc., doing business as Chi Institute, appeals the decision of the United States Patent and Trademark Office Trademark Trial and Appeal Board,[1] wherein the Board denied Chi Institute's opposition to registration of the trademark "Chi PLUS" on application of Xiaoming Wang ("Wang"), on the ground that there was no likelihood of confusion. We reverse the decision of the Board.

BACKGROUND

The determination of likelihood of confusion is a question of law based on underlying facts. Specialty Brands, Inc. v. Coffee Bean Distribs., Inc., 748 F.2d 669, 671 (Fed. Cir. 1984). Applying the criteria of the Administrative Procedure Act, 5 U.S.C. '706, we give plenary review to the Board's

---

[1] China Healthways Institute, Inc. v. Wang, Opposition No. 91157392 (TTAB April 28, 2006).

legal conclusion that confusion is not likely, see In re Int'l Flavors & Fragrances, Inc., 183 F.3d 1361, 1365 (Fed. Cir. 1999), and review the Board's findings of fact on the standard of support by substantial evidence. See On-Line Careline Inc. v. Am. Online Inc., 229 F.3d 1080, 1085 (Fed. Cir. 2000) (applying the APA to issues of likelihood of confusion).

Chi Institute makes and sells electric therapeutic massagers in association with the trademark CHI, illustrated in the trademark registration as follows:

The registration states first use in commerce in 1993.

Wang applied for registration of the mark CHI PLUS for "electric massage apparatus," and was accorded constructive use as of the application filing date of July 26, 2002, absent

evidence of actual use. The application illustrates the mark as follows:

Chi Institute filed an opposition on the ground that the two marks are so similar, in view of their use on the same kind of product, that there is a likelihood to cause confusion or mistake or to deceive. 15 U.S.C. §1052(d) provides:

> **§1052. Trademarks registrable on principal register; concurrent registration**
>
> No trademark by which the goods of the applicant may be distinguished from the goods of others shall be refused registration on the principal register on account of its nature unless it --
>
> * * * *
>
> (d) Consists of or comprises a mark which so resembles a mark registered in the Patent and Trademark Office, or a mark or trade name previously used in the United States by another and not abandoned, as to be likely, when used on or in connection with the goods of the applicant, to cause confusion, or to cause mistake, or to deceive: . . .

The Board found that confusion was not likely, and rejected the opposition. This appeal followed.

DISCUSSION

The Board found that the goods of applicant and opposer are legally identical and that they move in the same channels of trade to the same class of consumer. However, the Board found that "CHI" is a weak component of the marks, and the other components of the marks adequately distinguish them. In support of the position that the identical use of "chi" should receive little or no weight, the Board cited dictionary definitions that "chi" means vital energy and vital force in Chinese thought and medicine:

> THE AMERICAN HERITAGE DICTIONARY OF THE ENGLISH LANGUAGE (Fourth Edition):
>
> **chi** also ch'i or Qi or qi(che) n. The vital force believed in Taoism and other Chinese thought to be inherent in all things. The unimpeded circulation of chi and a balance of its negative and positive forms in the body are held to be essential to good health in traditional Chinese medicine. [Chinese (Mandarin) qi, air, spirit, energy of life.]

MERRIAM-WEBSTER'S COLLEGIATE DICTIONARY (Eleventh Ed. 2003):

> **chi** [Ch (Beijing) qi, lit., air, breath] vital energy that is held to animate the body internally and is of central importantance in some systems of Eastern medical treatment (as acupuncture) and of exercise or self-defense (as tai chi).

The Board concluded that "chi . . . has a well known meaning among those knowledgeable about Eastern medical treatments," and is "at least very highly suggestive, if not merely descriptive, when used in connection with the intended goods." On this basis the Board reasoned that the common CHI component of the marks is a relatively weak contributor to trademark status, and analyzed likelihood of confusion based on the differences, not the similarities, of the marks. Thus the Board concentrated its analysis on the difference between the stylized letter "I" in Chi Institute's mark, and the word "PLUS" in Wang's mark, and held that the marks are "distinguished by their respective additional matter."

We conclude that the Board erred in its analysis, for the word CHI is a significant component of these marks when viewed in their entirety. The marks must be compared in their entirety, at least when the overall commercial impression is reasonably based on the entirety of the marks. See Herbko Intern., Inc. v. Kappa Books, Inc., 308 F.3d 1156, 1165 (Fed. Cir. 2002) ("Turning to the relevant DuPont factors, the 'similarity or dissimilarity of the marks in their entireties' is a predominant inquiry. This inquiry examines the relevant features of the marks, including appearance, sound, connotation, and commercial impression. Although examining the marks in their entireties, the comparison, for rational reasons, may give more or less weight to a dominant feature of the marks.") (citations omitted).

The Board erred in declining to give any significant weight to the similarities of the marks, particularly in light of the identity of the goods, the identity of the intended consumers, and the identity of the channels of trade. The

word CHI has significant descriptive aspects that raise the likelihood of confusion and weigh against registration of multiple marks for identical goods. It is incorrect to compare marks by eliminating portions thereof and then simply comparing the residue. See Specialty Brands, Inc. v. Coffee Bean Distributors, Inc., 748 F.2d 669, 673 (Fed. Cir. 1984) ("Of paramount interest is not the descriptive nature of SPICE, but the overall commercial impression derived by viewing the marks in their entireties . . . . Arguments to the effect that one portion of a mark possesses no trademark significance leading to a direct comparison between only what remains is an erroneous approach.") Spice Islands v. Frank Tea & Spice Co., 505 F.2d 1293, 1295 (CCPA 1974); Specialty Brands, 748 F.2d at 672 ("Although applicant disclaimed the word "spice" apart from SPICE VALLEY as a whole, the marks are viewed in their entireties.") The word CHI is an integral part of both marks and must be given appropriate weight.

Accepting that the word "chi" has a meaning in Chinese traditional medicine, the word "chi" does not mean an electric therapeutic massager. Applying the DuPont factors to the marks viewed in their entirety, the addition of "plus" to a mark already established and in use in commerce for electric therapeutic massagers is indeed likely to cause confusion or mistake or to deceive. The similarities of the two marks are so strong as to be likely to lead customers to believe that the products to which they refer come from the same source. The word CHI is the major component of both marks, and in both it is set forth in heavy letters. The fact that in Wang's mark only the first letter, "C," is a capital letter, whereas in the Institute's mark all of the letters are shown as capitals, is unlikely to suggest different sources of the product. The addition of the word "PLUS" in Wang's mark is unlikely to avoid the confusion for "Plus" ordinarily connotes a related superior product, not one from a different source. And the

use of a square dot over the capital "I" in Wang's mark, instead of the circular dot atop two arms in the Institute's mark, is unlikely to prevent customer confusion over the source of the products to which these marks pertain.

Chi Institute provided evidence of actual confusion in the marketplace. The Board declined to consider this evidence, and also declined to consider Wang's purportedly countervailing evidence because it was not proffered during the assigned testimony period. Evidence of actual confusion is relevant to determination of likelihood of confusion, and to the extent that it was properly proffered it should have been considered. DuPont, 476 F.2d at 1361.

The Board criticized the absence of evidence from Chi Institute of its "market share," and criticized the evidence of Chi Institute's use of CHI on its products and in advertising. The Board gave little weight to China Healthways evidence that it has sold tens of thousands of electric massagers with the CHI mark, whereas Wang had only recently entered the

market with an electric massager. This too is a relevant factor. See DuPont, 476 F.2d at 1361 ("The market interface between the applicant and the owner of a prior mark" should be considered). Evidence of large sales volume and length of use is highly relevant, whatever the market share. See Giant Food, Inc. v. Nation's Foodservice, Inc., 710 F.2d 1565, 1569 (Fed. Cir. 1983) ("One of [the DuPont] factors is the fame of the prior mark, as measured by volume of sales, advertising, and length of use.")

Viewing the marks in their entirety, we conclude that confusion is likely as to the source of electronic massagers associated with the mark CHI and the mark CHI PLUS. The decision of the Board is reversed.[2]

REVERSED

---

[2] Wang states in his brief that a settlement in a district court action bars this appeal. China Healthways disputes that position, and neither side provides further exposition. We do not decide this aspect, which in all events appears to raise issues other than likelihood of confusion, where the Board must consider the public interest as well as that of the parties.

Appendix B

Opinion of United States Patent and Trademark Office,

Trademark Trail and Appeal Board, filed April, 28, 2006.

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

China Healthways Institute, Inc. dba Chi Institute

v.

Xiaoming Wang

Opposition No. 91157392

against Serial No. 76435273

David Z. Ribakoff of the Law Office of David Z. Ribakoff forChina Healthways Institute, Inc. dba Chi Institute.

Xiaoming Wang, *pro se*.

Before Walters, Bucher and Walsh, Administrative Trademark Judges.

Opinion by Bucher, Administrative Trademark Judge:

Xiaoming Wang seeks registration on the Principal Register of the following mark:

Chi PLUS

for "electric massage apparatus" in International Class 10.[1]

Registration has been opposed by China Healthways Institute, Inc. dba Chi Institute. As its ground for opposition, opposer asserts that applicant's mark when used in connection with applicant's goods so resembles opposer's

---

[1] Application Serial No. 76435273 was filed on July 26, 2002 based upon applicant's allegation of first use anywhere and first use in commerce at least as early as May 31, 2002. Applicant has disclaimed the word "Chi" apart from the mark as shown.

previously used mark, which opposer refers to as its "Chi logo," as to be likely to cause confusion, to cause mistake or to deceive under Section 2(d) of the Lanham Act.

Applicant, in its answer, has denied the salient allegations in the opposition.

The Record

By operation of the rules, the record includes the pleadings and the file of the opposed application. Opposer, as part of its case-in-chief, has also made of record the testimonial deposition of Richard H. Lee, president of China Healthways Institute, Inc., and exhibits thereto.

Although applicant failed to introduce any evidence during his assigned testimony period, he attempted to use his brief as

a vehicle for the introduction of evidence. Accordingly, in an order dated February 16, 2006, the Board granted opposer's motion to strike applicant's declaration and other exhibits attached to his brief, as well as any factual statements contained in applicant's main brief that rely upon this stricken material. Additionally, any of the materials previously submitted by applicant with his answer or in support of his response to opposer's motion for summary judgment are not of record for the purpose of this final determination and, therefore, have not been considered herein.

Procedural Matters

Before turning to the record and the merits of this case, we must discuss several preliminary matters.

In his answer, applicant asserted numerous "affirmative defenses," the majority of which are essentially

amplifications of his denials.[2] Applicant also asserted as affirmative defenses that opposer has committed fraud on the United States Patent and Trademark Office in several proceedings/prosecutions (¶ 19), and that opposer has been trying to obtain an illegal monopoly in this field, and as part of this attempt, has been guilty of intimidation against its competitors who are also marketing electric massage apparatus (¶ 20). Neither of these affirmative defenses has been considered because neither defense is acceptable as pleaded. Rule 9(b) of the Federal Rules of Civil Procedure requires that the circumstances constituting fraud be stated "with particularity." Hence, applicant's pleading of fraud is deficient because it is not stated with particularity.

---

[2] This includes applicant's assertion that "chi" is a generic term.

Applicant's pleading regarding an "illegal monopoly" is essentially a claim of unfair competition, which is not within the scope of the Board to determine. *See* TBMP 309.03(a)(1). Furthermore, applicant submitted no evidence in support of any of his claims. Therefore, applicant's allegations as to opposer's alleged fraud on the USPTO and its alleged acts of unfair competition have not been considered.

Both parties have also alluded to prior litigation between opposer herein and companies allegedly associated in some way with applicant. For example, copies of court documents correctly entered into this record by opposer show that opposer was the plaintiff in Civil Action No. CV02-03137 LGB (JWJx) filed in the United States District Court for the Central District of California, complaining of copyright infringement, trademark infringement, false advertising and unfair competition, brought against more than a dozen parties. While opposer did submit the court's order of April 1, 2005 from that proceeding, opposer did not plead collateral

estoppel or res judicata in its notice of opposition, nor has any such issue been tried herein. Also, applicant is not listed among the defendants in this court proceeding. Therefore, we find this evidence to have no relevance in this opposition proceeding and we have not considered opposer's allegations that applicant is the owner of one or more of the defendant companies in the civil proceeding, or that the court reached certain factual findings that should be applicable herein.

Factual Findings

China Healthways Institute, Inc. develops and manufactures therapeutic massagers that produce an infrasonic signal transmitted to the body through a transducer apparatus. This field of mind-body interventions is a form of alternative medicine growing out of traditional Chinese medicine. Opposer's literature discusses how the involved device acts on biofield forces, and hence, is able to reduce inflammation and the impacts of trauma; and that following

in the tradition of QiGong masters who claim to cure a wide variety of diseases with energy released from their fingertips, this electronic device offers external QiGong, or energy practice, for patients who seek to improve the flow and balance of energy in a beneficial way. Opposer has developed a nationwide customer base, including professionals in fields of complementary and alternative medicine such as chiropractors, massage therapists, physicians in practice of pain medicine, as well as chronic pain patients. Opposer has sold 2,000 to 3,000 massager units each year since 1993.

As noted, other than the involved application, applicant has offered no evidence for the record.

China Healthways Institute, Inc. has standing

Opposer's standing is a threshold inquiry made by the Board in every *inter partes* case. In *Ritchie v. Simpson*, 170 F.3d 1092, 50 USPQ2d 1023 (Fed. Cir. 1999), the Federal

Circuit has enunciated a liberal threshold for determining standing, i.e., whether one's belief that one will be (is) damaged by the registration is reasonable and reflects a real interest in the case. *See also Jewelers Vigilance Committee Inc. v. Ullenberg Corp.*, 823 F.2d 490, 2 USPQ2d 2021, 2023 (Fed. Cir. 1987); and *Lipton Industries, Inc. v. Ralston Purina Company,* 670 F.2d 1024, 213 USPQ 185 (CCPA 1982). Opposer's evidence of use of its CHI logo in connection with the sale and marketing of an electric massage apparatus for therapeutic use as well as with related accessories and replacement parts is sufficient to establish opposer's interest and, therefore, standing in this proceeding.

Priority

In the absence of any evidence of use, the earliest date that applicant can rely on is his constructive use date, his filing date herein, of July 26, 2002.

According to the testimony of Mr. Lee, opposer started selling massagers having the CHI logo in 1993. Opposer introduced into the record invoices from 1993 to 2005. These invoices identify the involved goods as "Infratonic QGM Med Device," "Infratonic QGM Ther Massagr" and "Infratonic QGM Therapeutic." However, none of the invoices contains the CHI logo, or even the word "Chi." (Exhibits 3- 5 to Lee testimony).

Nonetheless, Mr. Lee testified that all of opposer's various massagers, as the device has evolved over the past dozen years, had the CHI logo in the upper right hand corner of the faceplate. Lee testimony at p. 14. There is no basis in the record for the Board to question the accuracy of Mr. Lee's testimony. We note, however, from the copies of photographs of opposer's evolving machine (Exhibit 2 to Lee testimony), the first model where the CHI logo is clearly visible to us is the Infratonic 8 model, which opposer testified it started marketing in 2001 (Exhibit 2e). In any event, this date still

precedes the filing date of the opposed application. In view thereof, opposer has established its priority of use of its CHI and design mark.

Likelihood of Confusion

We turn, then, to the issue of likelihood of confusion under Section 2(d) of the Act. Our determination of likelihood of confusion is based upon our analysis of all of the probative facts in evidence that are relevant to the factors bearing on the issue of likelihood of confusion. *See In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563 (CCPA 1973). *See also In re Majestic Distilling Company, Inc.*, 315 F.3d 1311, 65 USPQ2d 1201 (Fed. Cir. 2003). In considering the evidence of record on these factors, we keep in mind that "[t]he fundamental inquiry mandated by Section 2(d) goes to the cumulative effect of differences in the essential characteristics of the goods and differences in the marks." *Federated Foods, Inc. v. Fort Howard Paper Co.*, 544 F.2d

1098, 192 USPQ 24 (CCPA 1976). *See also In re Azteca Restaurant Enterprises, Inc.*, 50 USPQ2d 1209 (TTAB 1999), and the cases cited therein.

The goods

We turn first to a consideration of the relationship of the goods as described in the application and in connection with which the prior mark is in use.

In its answer, applicant argues that his product is different from opposer's in appearance, characteristics and technology, that his devices are sold directly to health care consumers rather than to professionals such as chiropractors, massage therapists or physicians, and that his massagers are used in ways quite different from the way professionals use opposer's massagers. Although opposer argues that the parties' respective massagers are closely related, it makes several arguments not unlike those made by applicant about the differences in the parties' current products. For example,

in order to support its arguments about the severe damages it suffers when applicant tries to pass off his products as opposer's products, opposer discusses its continuous advances into patented digital technology, and alleges that applicant currently markets massagers having the technology, appearance and functionalities of its ten-year-old analog models.

However, for our purposes in determining likelihood of confusion, we note that the identification of goods in the application is not limited in any way, and therefore, we must conclude that both parties are involved in marketing devices correctly characterized as electric massage apparatus. As a result, we find that the goods involved herein are legally identical. This factor favors opposer. Similarly, as to two related *du Pont* factors, we must presume these respective parties' goods will move through all the same channels of trade to the same classes of ordinary consumers.

The Marks

We turn next to a consideration of the similarity or dissimilarity of the marks in their entireties as to appearance, sound, connotation and commercial impression. *See Palm Bay Imports Inc. v. Veuve Clicquot Ponsardin Maison Fondee En 1772*, 396 F.3d 1369, 73 USPQ2d 1689, 1692 (Fed. Cir. 2005).

As to appearance, both marks contain the word "chi." However, opposer's mark also contains a prominent, non literal image.[3] This image is accentuated elsewhere on the trade dress of the goods and on opposer's website, where it sometimes appears on its own, apart from the literal element.

---

[3] While opposer has not affirmatively established that its mark is inherently distinctive, we find that the prominent design element is sufficiently distinctive to render the mark inherently distinctive in relation to opposer's goods, regardless of any alleged weakness or lack of inherent distinctiveness in the term "chi" alone

By contrast, applicant's mark has the additional word "PLUS." As to sound, the difference will be the single syllable term "Chi" versus the two-word term, "Chi Plus."

As to connotation, opposer argues that the letters C·H·I in its mark represents an acronym or initialism for opposer's trade name, namely, "China Healthways Institute." Further, opposer's mark is described by its president as including "hands over the 'I' of the logo represent[ing] a person sitting up healthy (sic) in a hospital bed."

By contrast, applicant's mark is ChiPLUS, with the word "chi" disclaimed. Although applicant has disclaimed the word "chi," we cannot consider this as evidence that the term is merely descriptive or generic. An applicant cannot avoid a likelihood of confusion claim by disclaiming a portion of its mark. *See In re National Data Corp.*, 753 F.2d 1056, 224 USPQ 749 (Fed. Cir. 1985); *Specialty Brands, Inc. v. Coffee Bean Distributors, Inc.*, 748 F.2d 669, 672, 223 USPQ 1281,

1282 (Fed. Cir. 1984); *Giant Food, Inc. v. Nation's Foodservice, Inc.*, 710 F.2d 1565, 1570, 218 USPQ 390, 395 (Fed. Cir. 1983); *Schwarzkopf v. John H. Breck, Inc.*, 340 F.2d 978, 144 USPQ 433 (CCPA 1965); and *In re MCI Communications Corp.*, 21 USPQ2d 1534, 1538-39 (Comm'r Pats.1991).

While applicant has failed properly to place his evidence into the record, we can take judicial notice of dictionary entries defining the word "chi":

> **chi** [Ch (Beijing) *qi*, lit., air, breath] vital energy that is held to animate the body internally and is of central importantance in some systems of Eastern medical treatment (as acupuncture) and of exercise or self-defense (as *tai chi*), [4]

---

4 *MERRIAM-WEBSTER'S COLLEGIATE DICTIONARY* (Eleventh Ed. 2003). It is settled that the Board may properly take judicial notice of dictionary definitions. *See Hancock v. American Steel & Wire Co. of New Jersey*, 203 F.2d 737, 97 USPQ 330, 332 (CCPA 1953) and *University of*

chi also ch' i or Qi or qi(che) n. The vital force believed in Taoism and other Chinese thought to be inherent in all things. The unimpeded circulation of chi and a balance of its negative and positive forms in the body are held to be essential to good health in traditional Chinese medicine. [Chinese (Mandarin) qi, air, spirit, energy of life.] [5]

This connotation of the word "chi" is most relevant as applied to opposer's and applicant's therapeutic infrasonic massagers. We note, for example, that in discussions of putative energy fields that surround and penetrate the human body, "chi" is the equivalent of "Qi," and opposer's invoices of more than a dozen years identify the involved goods

---

Notre Dame du Lac v. J. C. Gourmet Food Imports Co., Inc., 213 USPQ 594, 596 (TTAB 1982), *aff'd*, 703 F.2d 1372, 217 USPQ 505 (Fed. Cir. 1983).

[5] *THE AMERICAN HERITAGE DICTIONARY OF THE ENGLISH LANGUAGE* (Fourth Edition).

as "QGM" therapeutic medical devices, where the letters QGM stand for "QiGong Machine." Further, opposer's literature touts the incredible cures caused by the capacity of its therapeutic massager's transducer to change the flows of vital energy within the patient's body.

Hence, while the letters "CHI" may also function as an acronym or initialism for opposer's trade name, China Healthways Institute, we find that the word "chi" has a well-known meaning among those knowledgeable about Eastern medical treatments, and it is this connection that provides the more likely connotation of the term "chi" in both parties' marks. Specifically, the "chi" portion of both marks is at the very least highly suggestive, if not merely descriptive, when used in connection with the involved goods.

While we must consider the similarity or dissimilarity of the marks when viewed in their entireties, "there is nothing improper in stating that, for rational reasons, more or less weight has been given to a particular feature of the mark,

provided [that] the ultimate conclusion rests on consideration of the marks in their entireties." *In re National Data Corp.*, *supra* at 751. We note that the only common element between the marks is the highly suggestive or merely descriptive term "chi." Therefore, we find that the marks are distinguished by their respective additional matter, and conclude that their overall commercial impressions are not similar.

Renown of the prior mark

Finally, we turn to the *du Pont* factor focusing on the fame of opposer's prior mark. In its notice of opposition, opposer refers to its "famous CHI ... trademark ...." We have concluded that cumulatively, opposer has indeed sold tens of thousands of these massager units since 1993. Each unit retails for prices that have ranged over the years from several hundred dollars to current prices approaching a thousand dollars. Nonetheless, we are not able to conclude that its CHI

logo is famous, or even well-known. For example, we do not know what market share opposer's sales of therapeutic massage machines represent, the extent to which the pleaded mark is used on the machines comprising opposer's total sales, or the prominence of the pleaded mark in opposer's advertising and promotion. Nor can we extrapolate from the evidence the relevant purchasers' perceptions of the mark.

Summary of Likelihood of Confusion Determination

In conclusion, while these goods must be deemed to be identical, given the relative weakness of the "Chi" component of opposer's composite mark and opposer's failure to establish that its mark is either famous or well known, we find there is no likelihood of confusion herein. *Kellogg Co. v. Pack'em Enterprises Inc.*, 951 F.2d 330, 21 USPQ 1142, 1143-44 (Fed. Cir. 1991) [FROOTEE ICE and elephant design is so different from FROOT LOOPS, that

even if goods were closely related, and opposer's mark were famous, there was no likelihood of confusion].

Decision: The opposition is hereby dismissed and the application will be forwarded for the issuance of a registration.